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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,244	02/18/2004	David M. Sabatini	WIBL-P01-010	5817
28120	7590	06/01/2005	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			ROOKE, AGNES BEATA	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,244

Applicant(s)

SABATINI ET AL.

Examiner

Agnes B Rooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 11, 12, 20, 22-30, 32 and 34-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 13, 15-19, 21, 31 and 33 is/are rejected.
- 7) ☒ Claim(s) 10, 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/02/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-60 are pending.

Applicant's election with traverse of Group III, Claims 8-21 and 31-33 in the reply filed on March 2, 2005 is acknowledged. Applicants elected SEQ ID NO:2 drawn to p200 or rictor polypeptide (See page 8 of the specification). Therefore, claims 8-10, 13-19, 21, 31, and 33 are under examination (SEQ ID NO:1, 2, and 3).

The traversal is on the ground that it would not be an undue burden to examine the Claims of Group V, claims 28-30 referring to a method of detecting the nucleic acid. Examiner respectfully disagrees because even though Groups III and V are classified in class 435, Group II refers to nucleic acid, vector, host cell, a kit, and a method of making a protein, where Group V refers to a method of detecting the nucleic acid. Therefore, separate searches would have to be performed for these distinct methods and the argument is not found persuasive.

Further, Applicant argues that the various sequences subject to election requirement are encompassed by a Markush group, and that the members of the Markush group are sufficiently few in number and may be searched and examined without a serious burden on the office. Examiner respectfully disagrees because the Group I is directed to distinct proteins, and Group III is directed to distinct nucleic acids, and therefore the argument is found not to be persuasive.

The restriction requirement is still deemed proper and is therefore made final.

Claims 1-7, 11, 12, 20, 22-30, 32, and 34-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims.

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Claims 8-10, 13-19, 21, 31, and 33 are currently under examination.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 9, 13, 15-19, 21, 31, and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 8, Applicant refers to a nucleic acid sequence that hybridizes under high stringency conditions to a nucleic acid SEQ ID NO:2. The claim must be clear regarding chemical parameters, in this case the high stringency conditions during hybridization of the nucleic acids.

In Claim 13, the appropriate nucleic acid sequence encoding a rictor polypeptide must be provided, since examiner cannot interpret the claim accordingly without the sequence. If the sequence of the nucleic acid is unknown the function of the composition cannot be ascertained, therefore the structure of the polypeptide does not necessary correspond with its function.

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In Claim 15, the structure of the nucleic acid encoding an mTOR-AP polypeptide must be provided. Applicant claims that the nucleic acid has 70% identity to the SEQ ID NO:3, however the 70% identity does not necessary encodes polypeptide that would have a function of mTOR-AP polypeptide. Therefore, the structure of the polypeptide does not necessary correlate with its function.

In Claims 19 and 21, the structure of the mTOR-AP polypeptide must be provided. If the structure of the polypeptide is unknown, it is impossible to ascertain its function.

In Claim 33, the structure of the primer or probe is impossible to ascertain, since the probe or primer binds to a nucleic acid that has only 70% identity to SEQ ID NO:2. Thus, the structure of the probe cannot known, since it can bind to any part of the nucleic acid that has 70% identity to the SEQ ID NO:2.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8, 9, 13, 15, 17-19, 21, 31, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 8, 9, 15, the proper phrase to express percent identity is a sentence stating that "a sequence has at least 70% identity to the SEQ ID NO:2," for example.

In Claim 8, the phrase "high stringency" is indefinite, and must be more specifically defined, for example by giving chemical parameters for the hybridization conditions.

In Claim 13, the structure of a rictor polypeptide is not provided.

In Claims 19 and 21, the structure of mTOR-AP polypeptide is not provided.

In Claim 33, the structure of nucleic acid encoding a rictor polypeptide is not provided, therefore the structure of the probe or a primer cannot be ascertained.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 8 a), 15, 31, and 33 are rejected under 35 U.S.C. 102(a) as being anticipated by Ohara et al., Characterization of size-fractionated cDNA libraries generated by the in vitro recombination-assisted method, DNA Res., (2002), 9(2), p. 47-57.

According to the U.S. PTO search using GenCore version 5.1.6. the records indicate that SEQ ID NO:2 has 74.7% identity to the sequence by Ohara et al., which was also submitted in Japan on 26 March, 2002. Please see attached copy of the sequence search.

Therefore, Ohara et al. would anticipate nucleic acid sequence that has at least 70% identity to the SEQ ID NO:2 in Claim 8.

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According to the U.S. PTO search using GenCore version 5.1.6. the records indicate that SEQ ID NO:3 has 75.3% identity to the sequence by Ohara et al. (EMBL; AB082530; BAC02708.1). Please see attached copy of the sequence search.

Therefore, Ohara et al. would anticipate nucleic acid sequence that has at least 70% identity to the SEQ ID NO:3 in Claim 15.

Claims 31 and 33 are included in the rejection because a kit refers to the probe or primer nucleic acid, which is a nucleic acid that is at least 70% identical to the SEQ ID NO:2, and therefore the kits are not novel.

Conclusion

Claims 9, 10, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

AR

A handwritten signature in cursive script, reading "Karen Cochrane Carlson" followed by a stylized monogram or initials.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER

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